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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,866	03/31/2004	Gary A. Schultz	200701/1230	5574
7590 Michael L. Goldman Nixon Peabody LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051	05/07/2007		<div style="border: 1px solid black; padding: 2px;">EXAMINER</div> <div style="border: 1px solid black; padding: 2px;">WELLS, NIKITA</div> <div style="display: flex; justify-content: space-between;"><div style="border: 1px solid black; padding: 2px;">ART UNIT</div><div style="border: 1px solid black; padding: 2px;">PAPER NUMBER</div></div> <div style="border: 1px solid black; padding: 2px;">2881</div>	
			<div style="display: flex; justify-content: space-between;"><div style="border: 1px solid black; padding: 2px;">MAIL DATE</div><div style="border: 1px solid black; padding: 2px;">DELIVERY MODE</div></div> <div style="border: 1px solid black; padding: 2px;">05/07/2007</div> <div style="border: 1px solid black; padding: 2px;">PAPER</div>	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/813,866	SCHULTZ ET AL.	
	Examiner	Art Unit	
	Nikita Wells	2881	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>31 March 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of US Patent No. 6,633,031 B1.

Although the claims of the application are not identical to the claims of the patent, the claims are not patentably distinct from each other and claim common subject matter disclosing an electrospray device comprising: a substrate having an injection surface and an ejection surface, wherein the substrate comprises: an entrance orifice on the injection surface; an exit

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orifice on the ejection surface; a channel extending between the entrance orifice and the exit orifice; a recess extending into the ejection surface, thereby defining a nozzle on the ejection surface; and a voltage application system comprising: a first ring electrode circumscribing the nozzle to impart a first potential wherein the nozzle is substantially coplanar with or protrudes through a plane defined by the ring electrode to impart a first potential to said substrate and a second electrode to impart a second potential, wherein the first and the second electrodes are positioned to define an electric field.

Independent claims 1 and 18 of the application correspond independent claims 1 and 11 of the patent. Claims 2, 5, 6, 10, and 11 of the application correspond to claims 2, 4, 3, 5, and 6, of the patent, respectively. Claims 15, 19, and 24, of the application correspond to claims 10, 12, and 8, of the patent, respectively.

Except for the double patenting problem as described above no prior art discloses applicant's invention.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schultz et al. (6,822,231 B2) disclose an integrated monolithic microfabricated dispensing nozzle and liquid chromatography-electrospray method and system.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikita Wells whose telephone number is (571) 272-2484. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (571) 272-

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2293. The central fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nikita Wells

Primary Examiner, Art Unit 2881

May 1, 2007